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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,654	04/14/2004	Yoshio Terada	Q81096	4963
65565	7590	02/04/2009		
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
DOUYON, LORNA M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,654

Applicant(s)

TERADA ET AL.

Examiner

Lorna M. Douyon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8,9,11-16,20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,8,9,20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-083)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2008 has been entered.
2. Claims 5, 8-9, 11-16, 20 and 23 are pending. Claims 11-16 are withdrawn from consideration as being drawn to a nonelected invention.
3. The rejection of claims 5, 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over Suzuura et al. (US Patent No. 6,066,404) is withdrawn in view of Applicants' amendment.
4. The rejection of claims 5, 8-9, 17-19 under 35 U.S.C. 103(a) as being unpatentable over Namikawa et al. (WO 01/94036) is withdrawn in view of Applicants' amendment.
5. The rejection of claims 20 and 23 under 35 U.S.C. 103(a) as being unpatentable over Namikawa as applied to the above claims, and further in view of Terada et al. (WO 03/052045) is withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 5, 8-9, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada et al. (WO 03/052045), hereinafter "Terada".

Terada teaches a cleaning label which comprises a cleaning layer **3** and a release film **4** provided on one side of a backing **2** and an ordinary adhesive layer **5** provided on the other side of the backing **2** and is peelably provided on the separator **1** with this adhesive layer **5** interposed therebetween; and in operation, the cleaning label is peeled off the separator **1**, and then stuck to a conveying member such as semiconductor wafer (see page 29, lines 9-23, Figures 1 and 2). The cleaning layer is not specifically limited in its material (see page 19, lines 24-25). The backing for the cleaning layer is not specifically limited, and one example is polyimide (see page 24, lines 18-21). It is construed that the cleaning layer, then comprises polyimide. The release film (i.e., protective film) is treated with a silicone-based releasing agent and is laminated as a separator, wherein the amount of silicone attached to said cleaning layer when the separator is peeled off said cleaning layer is 0.005f g/m^2 or less as calculated in terms of polydimethylsiloxane (see page 6, line 19 to page 7, line 9; page 8, lines 13 to page 10, line 21). The release film to be used in the protection of the cleaning layer may be a film made of polyethylene, polypropylene, polybutene, polybutadiene or

polymethylpentene (see page 27, lines 21-24), which has been release-treated with a silicone-based releasing agent, a long-chain alkyl-based releasing agent, a fluorine-based releasing agent, an aliphatic acid amide-based releasing agent or a silica-based releasing agent (see page 28, lines 4-8). Terada, however, fails to specifically disclose a cleaning layer comprising a polyimide resin wherein each of the relative intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, is 0.1 or less, and the cleaning layer having a tensile modulus and adhesive strength as those recited.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared the cleaning layer with polyimide because this is one of the selections taught by Terada, and to reasonably expect each of the relative intensities of the recited fragment ions in the cleaning layer, when the protective film is peeled off the cleaning layer, to be within those recited, i.e., 0.1 or less, and the cleaning layer having a tensile modulus and adhesive strength to be within those recited because similar cleaning material with similar layers and compositions have been utilized.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Response to Arguments

8. Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

